



In the United States Patent and Trademark Office

Serial Number: 09/575,186
Application Filed: May 23, 2000
Applicant: Kia Silverbrook and Paul Lapstun
Application Title: Method and System for Creation of a Photo Album
Examiner/GAU: David Yiuk Jung 2134

Dated September 14, 2005
At: Balmain, NSW
Docket No. NPA020US

REPLY

Commissioner for Patents
Washington, District of Columbia 20231

Dear Sir:

This paper is submitted in response to the Advisory Action mailed August 4, 2005 in relation to the above referenced application. The Applicant respectfully requests consideration of the following remarks.

The Advisory Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the previous Office Action.

Response to Arguments

Referring to the Examiner's comments with respect to the term "coded data" in this section of the Office Action, the Applicant respectfully highlights to the Examiner that

"The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity" (MPEP 706).

As stated in our previous response, the Examiner's comments in this section are unclear, and the Applicant has not been given an appropriate opportunity to reply. If the Examiner is asserting that there is a lack of clarity with respect to the claim, and in particular, believes that the term "coded data" is unclear, then such a proper objection should have been raised. Furthermore, the Examiner has not stated whether the Examiner's belief that the term "coded data" lacks clarity is relevant to the claim rejections raised under 35 USC 103. Accordingly, the Applicant highlights to the Examiner section MPEP 706.02(j) which states:

"It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply"

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Thus, the Applicant respectfully submits that, as stated in our previous Office Action response, the Applicant is finding it difficult to appropriately respond to the Office Action, and respectfully requests that the Examiner clarify the objection.

In any event, although the Examiner has not explicitly raised a clarity objection, the Applicant respectfully submits that a person skilled in the art will be able to understand what is meant by the term "coded data", and thus, the term is clear.

The Applicant refers the Examiner to the following passages from the MPEP, which state that a claim must be read in view of the specification, and should be interpreted in a way in which a person skilled in the art would interpret the claim.

During patent examination, the pending claims must be "given (their) broadest reasonable interpretation consistent with the specification." >In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). (MPEP 2111)

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (MPEP 2111).

See also In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). (MPEP 2111.01).

As previously highlighted to the Examiner, Figure 1 and the associated description in the specification, clearly show coded data 3, which is in this example, printed as a collection of tags 4. Thus it is clearly evident that the coded data shown in Figure 1, is readable by a sensing device and is indicative of an identity of the reference form and at least one position of the sensing device.

The Examiner has also questioned how coded data is different from any other types of information. As outlined in our previous response, the claim is explicit that information and the coded data are separate and therefore should be assessed on this basis. The Applicant respectfully submits that a claim should not be rejected because of the type of language used to define the subject matter for which protection is sought. Additionally, *"the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope... the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art"* (in reference to the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), and *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished). See MPEP 2173.01, 2173.02 and 2111.01).

Thus, a skilled reader of the claim would understand that the coded data and information are different and that the differences should be understood based on the rest of the wording of the claim. We therefore respectfully submit that the claim explicitly requires that information and coded data are different.

Accordingly, we highlight that the claim makes it clear that coded data can be sensed by the sensing device and that the coded data is in some way indicative of the identify of the photo album form and at least one reference point of the photo album form. No such requirements are made with respect to information, and thus it is perfectly clear to the skilled reader, not only that the coded data and information are different, but also how they can be different. For example, coded data must be capable of being sensed by a sensing device whilst information need not.

We therefore respectfully submit that the term "coded data" is perfectly clear from the claim wording and there is no need for further details.

Claim Rejections 35 USC 103(a)

The Examiner has maintained his rejections with regard to claims 1 to 45 under 35 U.S.C 103(a) as being unpatentable over Cass (US Patent No. 5,692,073).

The Applicant respectfully submits that claim 1 is patentable over Cass.

In particular, claim 1 describes a method of enabling the creation and use of a photo album, which the Examiner has asserted is shown in figure 21 of Cass. However, figure 21 of Cass shows a paper copy of a print out of a page 1100, which may include images (see Column 17 line 7). There is no description in Cass of a creation and use of a photo album.

Additionally, claim 1 describes a photo album form containing information relating to a photo album activity and coded data. The coded data is indicative of an identity of the photo album form and at least one reference point of the photo album form.

In contrast, Cass describes a Paper Web, where a user marks a piece of paper with an X (akin to clicking on a hyperlink) and scans the marked paper to a computer. The Paper Web then interprets these marks made by the user and follows the links to retrieve the pages corresponding to the mark made by the user (see Column 17 lines 4 to 16). Cass does not describe the pages having information related to photo album activity and coded data. Even if the Examiner is alleging that the marks made by the user are "coded data", these marks are not indicative of an identity of the page which they mark, or at least one reference point of that page. The Applicant fails to see any description, suggestion, or teaching in Cass of a page having coded data indicative of an identity of the photo album form and at least one reference point of the photo album form.

Consequently, Cass teaches away from the present claim 1, as Cass sends information regarding the marked X to a computer, where the mark X represents the link to the next page that the user wants to view. In contrast, the coded data in the present claim 1 describes the identity of the current page.

The Applicant respectfully highlights section 2143.01 of MPEP which states:

*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.*

Thus, the Applicant respectfully submits that a prima facie case of obviousness is not established as Cass describes a system which teaches away from the present claim 1, and the modification of Cass such that the coded data identifies the current page would change the principle of operation of Cass.

Furthermore, the current claim 1 describes a computer system receiving indicating data from a sensing device operated by the user. The indicating data includes the identity of the photo album form and a position of the sensing device relative to the photo album form, when the sensing device is placed in an operative position relative to the photo album form. In contrast, Cass describes the Paper Web pages being scanned or faxed to a computer (see Column 17 lines 6 to 7). There is no suggestion or teaching in Cass of the sensing device being able to send indicating data to a computer, where the indicating data includes the identity of the photo album form and a position of the sensing device.

In order to establish a prima facie case of obviousness, MPEP 706.02(j) states:

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, as there is no suggestion, or motivation to modify Cass to teach the method as described by claim 1, and as Cass does not teach or suggest all of the claim limitations, the present claim 1 is patentable over Cass.

The Applicant further submits, that as previously highlighted, the dependent claims in the present application present further features which are patentable over the cited prior art. For example, claim 4 of the present application describes movement of the sending device relative to the page and requires that such movement is detected. There is absolutely no disclosure of any such operation in Cass, and thus at least claim 4 is patentable in view of Cass.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 USC § 103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicants:



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